

REMARKS

Applicants hereby traverse the outstanding objections and rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-20 are pending in this application.

New Title

The title of the invention has been deemed to be not descriptive of the invention. In response, Applicants have changed the title to be descriptive of the invention as defined in the claims. No new matter has been entered. Thus, Applicants believe that the new title should satisfy the requirements of the Office Action.

Rejection under 35 U.S.C. § 103

Claims 1-6, 9-11, and 14-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlap et al. ('552, hereinafter Dunlap) in view of Yamamoto ('338).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

Lack of Motivation

The Office Action admits that Dunlap does not teach having an analog to digital converter for converting said analog video output into digital and at least one recorder employing a digital storage medium. The Office Action attempts to cure this deficiency by introducing Yamamoto, which the Office Action alleges to teach having such elements. The motivation for making the combination was presented as follows:

“It would have obvious ... to incorporate the A-D converter 9 and disc recorder 13 as taught by Yamamoto et al into Dunlap et al's system in order to increase the quality of the video signal to be duplicated.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Using a digital converter will not affect the quality of the video signal that is to be duplicated. In other words the video signal is not changed by adding a digital converter. Moreover, in comparing the analog signal with the converted digital signal, by definition, the converted digital signal has less information than the analog signal, and thus the digital signal is of less quality than the analog signal. Furthermore, Applicants believe that Dunlap will not benefit from the teachings of Yamamoto. Yamamoto is addressing tape degradation that occurs in mass production of tapes. Over time, a master tape will degrade from being replayed at high speed for many times, see column 1, lines 54-63 of Yamamoto. Dunlap is directed to a consumer electronic device, and thus does not involve the mass production of tapes using high speed duplication. Thus, Dunlap will not experience the problems that are solved by Yamamoto, and consequently, there is no desirability to incorporate Yamamoto into Dunlap. The language of the stated motivation is then merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Dunlap and Yamamoto is desirable. Therefore, the rejection of claims 1-6, 9-11, and 14-19 should be withdrawn.

Lack of Claimed Elements

The Office Action admits that Dunlap does not teach having an analog to digital converter for converting said analog video output into digital and at least one recorder employing a digital storage medium. The Office Action attempts to cure this deficiency by introducing Yamamoto, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a key frame marker for inserting at least one marker into the digital data. Basis for this limitation exists in the application, for example see page 8, line 22 of the specification. No new matter has been entered. Dunlap does not disclose at least this limitation. Dunlap does not involve digital data. Yamamoto does not disclose at least this limitation. Applicants cannot locate any corresponding element in Yamamoto. Thus, the combination of references does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-6 and 9 depend directly from base claim 1, and thus inherit all limitations of claim 1. Each of claims 2-6 and 9 sets forth features and limitations not recited by the combination of Dunlap and Yamamoto. Thus, the Applicants respectfully assert that for the above reasons claims 2-6 and 9 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103

Claims 7-8, 12-13, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlap in view of Yamamoto, as applied to claims 1, 10, and 19, in further view of Tognazzini ('147).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

Lack of Motivation

This rejection depends on the rejection of claim 1, 10, and 19. The motivation used in the rejection of claims 1, 10, and 19 is deficient as discussed above. The motivation of this rejection does not cure the deficiency of the motivation of the rejection of claims 1, 10, and 19. No valid suggestion has been made as to why a combination of Dunlap, Yamamoto, and

Tognazzini is desirable. Therefore, the rejection of claims 7-8, 12-13, and 20 should be withdrawn.

Lack of Claimed Elements

Base claim 1 is defined as described above. The combination of Dunlap and Yamamoto does not disclose these limitations, as discussed above. Tognazzini also does not disclose the all of limitations of claim 1. Tognazzini is directed to the recording of program or a scene from the beginning, after the program or scene has started. Tognazzini does not insert at least one marker into the digital data. Therefore, the combination of references does not teach all elements of the claimed invention.

Claims 7-8 depend directly from base claim 1, and thus inherit all limitations of claim 1. Each of claims 7-8 sets forth features and limitations not recited by the combination of references. Thus, the Applicants respectfully assert that for the above reasons claims 7-8 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

Claims 7 and 8 have been amended to correspond to claim 1. No new matter has been entered.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Application No.: 09/368,792

Docket No.: 10981001-1

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2026, under Order No. 10981001-1 from which the undersigned is authorized to draw.

Dated: September 16, 2003

Hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256034867US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 09-16-2003

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